

**REMARKS**

This Amendment is filed in response to the Office Action mailed April 23, 2007, The Applicant respectfully requests reconsideration of the rejections presented therein. All such rejections are respectfully traversed.

Claim 1-34 are pending in the case.

Claim 32 has been amended.

Claims 33-34 were added. Such claims incorporate features similar to those recited in indicated allowable claims 5, 10, 16 and/or 28 and accordingly are believed to be allowable.

***Claim Rejections - 35 U.S.C. §101***

At paragraphs 3-4 of the Office Action, claim 32 was rejected under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter. Such rejection appears to be in relation to use of the phrase “executable program instructions.” While the Applicant believes it was implicit in the original wording of claim 32 that the “executable program instructions” are executable by a computer, the Applicant now makes this explicit, reciting “computer executable program instructions.” Accordingly, the Applicant respectfully requests favorable action.

At paragraphs 5-14 of the Office Action, claims 1-29 were rejected under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter. While the basis of rejection varies slightly depending on the particular claim, each of the rejections allege the claims falls within a judicial exception, i.e. are directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature, and then discuss the physical transformation test and concrete and tangible result tests that may save a claim that falls into a judicial exception. The Applicant respectfully urges that the claims do not fall within a judicial exception. Thus, the physical transformation test and concrete and tangible result test never need be reached.

Specifically, while the Office Action alleges the claims are directed to an “abstract idea...seeking patent protection for [a] computer program in the abstract” such interpretation is inconsistent with the wording of the claims. Each of the claims includes reference to physical structures in which any computer programs referenced in the claims are embodied or operate. Thus, the computer programs are not “in the abstract,” but rather **claimed as part of an otherwise statutory manufacture or machine, or as part of a method of operating an otherwise statutory manufacture or machine**

For example, claim 17, representative of the apparatus claims, is directed to “[a]n *intermediate network device* for forwarding packets within a computer network, the device comprising: a plurality of interfaces... [and].a memory” (emphasis added). Thus to the extent the claim may cover computer programs they are not in the abstract, but part of an otherwise statutory manufacture or machine, i.e., an intermediate network device.

Similarly, claim 1, representative of the method claims, is directed to “[a] method *for use by an intermediate network device having a plurality of interfaces...*the method comprising...” (emphasis added). Thus to the extent the claimed steps may be implemented by computer programs, such implementation is to occur as part of a method of operating an otherwise statutory manufacture or machine, i.e., an intermediate network device.

The USPTO’s “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” published in the Nov. 22, 2005 edition of the Office Gazette, directly support the Applicant’s reasoning. ANNEX IV: under the heading “(a)” of the Guidelines state (emphasis added):

Computer programs are often recited as part of a claim. **USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim.** The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. **Only when the claimed invention taken as a whole is directed to a mere program**

**listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.**

Accordingly, the Applicant respectfully requests reconsideration of the rejections under 35 U.S.C. §101 and respectfully urges that the claims 1-29 are statutory.

***Claim Rejection - 35 U.S.C. §103***

At paragraphs 15-16 of the Office Action, claims 1, 3-6, 11-16, 22-24, 27-30 and 32 were rejected under 35 U.S.C. §103(a) over Varghese et al., U.S. Patent No. 6,560,236 (hereinafter Varghese), in view of Ogawa et al., U.S. Patent Publication No. 2002/0075872 (hereinafter Ogawa).

The Applicant respectfully notes that claims 5, 16 and 28 appear to have been included in the rejection in error, as the Examiner indicates these claims are allowable at paragraph 20 of the Office Action.

Further, the Applicant respectfully urges that Ogawa does not qualify as prior art under any section of 35 U.S.C. §102, and accordingly may not properly be used in a rejection under 35 U.S.C. §103.

35 U.S.C. §102(a) states in relevant part that a person is entitled to a patent unless “the invention was... patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.” Ogawa does not qualify as prior art under §102(a) because the invention was invented by the Applicant prior to Sept. 27, 2001, the filing date of this Application, while Ogawa was not published until June 20, 2002.

35 U.S.C. §102(b) states in relevant part that a person is entitled to a patent unless “the invention was patented or described in a printed publication in this or a foreign country.... more than one year prior to the date of the application for patent in the United States.” As Ogawa does not qualify as prior art under §102(a), it cannot qualify as prior art under §102(b).

Thus we are left with 35 U.S.C. §102(e). MPEP §2136.03(II) provides a methodology for determining the critical reference date of a reference that claims priority to an International (PCT) application. When such methodology is applied, it is clear Owaga should be accorded a date after the Applicant's filing date and is thus not prior art.

Specifically, MPEP §2136.03 (II) states “[i]f the potential reference resulted from, or claimed the benefit of, an international application, the following must be determined...” and presents three categories (A, B, and C) into which the reference may fall. Owaga is a continuation of PCT/JP99/05373 filed on Sept. 30, 1999. Accordingly, it falls into category C which the MPEP states is for “if the international application has an international filing date prior to November 29, 2000.”

Further, Owaga is a published application and thus falls into subcategory (2) under category C, which provides:

For U.S. application publications and WIPO publications directly resulting from international applications under PCT Article 21(2), never apply these references under 35 U.S.C. 102(e). These references may be applied as of their publication dates under 35 U.S.C. 102(a) or (b).

Thus, according to the methodology set forth by the MPEP, Owaga does not qualify as prior art under 35 U.S.C. §102(e).<sup>1</sup>

As Owaga does not qualify as prior art under any section of 35 U.S.C. §102, its use in a rejection under 35. U.S.C. §103 is believed to be inappropriate.

We are therefore left with only Varghese. There appears to be agreement that Varghese does not teach or suggest several aspects of the Applicant's claims. For example, at page 8 of the Office Action the Examiner comments “Varghese et al. do not

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<sup>1</sup> The Applicant further notes that the U.S. Patent that eventually issued from Owaga also does not qualify as prior art under 35. U.S.C. §102(e) as §2136.03(II)(C)(1) directs one accord the reference the 35 U.S.C

disclose explicitly receiving on an inbound interface a packet having a site-local unicast identifier; identifying the VLAN designation associated with the received packet; utilizing the identified VLAN designation to retrieve the site identifier to which the VLAN designation is mapped; creating a modified destination address; and rendering a forwarding decision for the received packet based on the modified destination address.”

In light of the non-prior art status of Owaga, and the deficiencies of Varghese, the Applicant respectfully urges the claims are not obvious under 35 U.S.C. §103.

At paragraphs 17 of the Office Action, claims 2, 20, 21, 25, 26 and 32 rejected under 35 U.S.C. §103(a) over Varghese, in view of Ogawa, in further view of Flanders et al., U.S. Patent No. 6,172,980 (hereinafter Flanders).

Claims 2, 20, 21, 25, 26 and 32 are dependent claims that depend from claims believed to be allowable for the reasons discussed above. Thus, in light of such dependency claims 2, 20, 21, 25, 26 and 32 are also believed to be allowable for at least this reason.

At paragraphs 18 of the Office Action, claims 7-9 and 18 rejected under 35 U.S.C. §103(a) over Varghese, in view of Chang et al., U.S. Patent No. 6,728,249 (hereinafter Chang).

The Applicant respectfully notes that the rejection makes no mention of Owaga, despite the fact that claims 7-9 and 18 are dependent claims that depend from claims rejected over a combination including Owaga. Indeed, it appears the basis for this rejection is not consistent with the Examiner’s new interpretations of Varghese discussed at page 8 of the Office Action. Accordingly, the Applicant respectfully requests clarification.

At paragraphs 19 of the Office Action, claim 19 was rejected under 35 U.S.C. §103(a) Varghese, in view of Chang, in view of Muller et al., U.S. Patent No. 5,938,736 (hereinafter Muller).

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371 national stage entry date, which for Owaga was Feb. 13, 2002, or the filing date of the U.S. application, both of which are later than the Applicant’s filing date.

The Applicant respectfully notes that the rejection makes no mention of Owaga, despite the fact that claim 19 is a dependent claim that depends from claims rejected over a combination including Owaga. Indeed, it appears the basis of this rejection is not consistent with the Examiner's new interpretations of Varghese discussed at page 8 of the Office Action. Accordingly, the Applicant respectfully requests clarification.

In the event that the Examiner deems personal contact desirable in disposition of this case, the Examiner is encouraged to call the undersigned attorney at (617) 951-2500.


All independent claims are believed to be in condition for allowance.

All dependent claims are believed to be dependent from allowable independent claims.

The Applicant respectfully solicits favorable action.

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,

  
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